



PATENT  
Attorney Docket No. 213839-00013

24  
LB  
9/1/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: McCafferty, *et al.*

Serial No.: 09/726,219

Filed: November 28, 2000

Title: Methods for Producing  
Members of Specific Binding  
Pairs

Group Art Unit: 1627

Examiner: P. Ponnaluri

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the  
United States Postal Service as first class mail in an  
envelope addressed to: Mail Stop DD, Commissioner for  
Patents, Alexandria, VA 22313-1450, on this date.

05/05/03  
Date

David W. Clough, Ph.D.  
Registration No. 36,107

**FIRST SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT  
PURSUANT TO 37 C.F.R. § 1.97-1.99  
FILED WITH PETITION TO EXPUNGE  
PURSUANT TO 37 C.F.R. § 1.59**

Mail Stop DD  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RECEIVED  
MAY 12 2003  
TECH CENTER 1600/2900

Dear Sir:

This Information Disclosure Statement is being submitted pursuant to the applicants' duty of candor and in particular to the applicants' duty to disclose, under MPEP §2001.06(c), information from related litigation such as the charges of inequitable conduct in the parent of the present application, now U.S. Patent No. 5,969,108 (the '108 patent). Applicants request that the documents listed on the attached Form PTO/SB/08A be made of official record in the above-identified application and considered by the Examiner. Our check in the amount of \$180 is also enclosed pursuant to 37 C.F.R. § 1.17(p).

Some of the documents being submitted are subject to a protective order in Civil Action No. 1:00 CV 00146 and are being submitted in a sealed, clearly labeled envelope for consideration under MPEP § 724. A Petition to Expunge under 37 C.F.R. § 1.59, along with

05/08/2003 SLUANG1 00000014 501214 09726219

02 FC:1806

180.00 CH  
Doc # CH01 (213839-00013) 50103666v1;05/03/2003/Time:14:33

the fee of \$130 pursuant to 37 C.F.R. § 1.17(h) are also enclosed herewith. If the submitted documents are found not to be important in deciding whether to allow the application to issue as a patent, applicants respectfully request that the Petition to Expunge under 37 C.F.R. § 1.59 be granted and the documents identified below be returned to the attorney for applicant.

1. Agreement between Medical Research Council, Cambridge Antibody Technology Limited and Cambridge Antibody Technology Group plc, dated 1/7/97 (financial terms redacted);
2. Chiswell memo, dated July 30, 1990, transmitting a copy of the Collaborative Agreement between Cambridge Antibody Technology and The Medical Research Council, dated July 27, 1995; and
3. Administration Agreement between Cambridge Antibody Technology Ltd. and Medical Research Council, 8/1/91 (financial terms redacted).

This same Supplemental Information Disclosure Statement is being filed simultaneously in related application nos. 09/196,522; 09/196,673; 09/309,639; 09/416,902; 09/196,586; 09/417,479; 09/706,507; and 09/726,219. Each of these related applications is currently under examination by Examiner Ponnaluri. In view of the filing of the Petition to Expunge, applicants are transmitting a single copy of the cited references for consideration in each of the related applications.

**Inequitable Conduct Allegations Involving  
U.S. Patent No. 5,969,108 (parent of the present application)**

The following is a brief summary of the allegations being made by MorphoSys AG with respect to inequitable conduct in obtaining the '108 patent. MorphoSys has alleged inequitable conduct on the part of Cambridge Antibody Technology Limited, ("CAT"), one of the assignees of the '108 patent, in obtaining the '108 patent. The subject matter claimed in the '108 patent generally relates to the display of single chain antibodies on the surface of filamentous bacteriophage.

One of the bases for the allegation of inequitable conduct is that the applicants did not disclose to the U.S. Patent & Trademark Office a National Institute's of Health ("NIH") grant application by Dr. George Smith relating to the display of small peptides on the surface of phage and which contains a prophetic disclosure of the display of single chain antibodies on the surface of phage which Dr. Smith characterized as speculative in the text of the grant.

Documents (including deposition testimony) submitted herewith relate *inter alia* to the specific allegations made by MorphoSys with regard to this issue, including communications between CAT personnel and their attorneys relating to their knowledge of the existence and public availability of the Smith grant application, and the allegedly cumulative nature of the application in view of what was already before the Patent Office and Dr. Smith's own characterization of what would constitute the invention of the display of single chain antibodies on phage made in a "Declaration" several years after his receipt of the NIH grant.

There is disagreement between CAT and MorphoSys regarding *inter alia* the actual public availability of a Smith grant application, its alleged cumulative and speculative nature in view of material already before the U.S. Patent & Trademark Office and the problems cited by Dr. Smith in his discussion of the display of single chain antibodies on phage in the grant application.

An allegation has also been made that CAT engaged in inequitable conduct by not disclosing to the Patent Office the Smith grant application as relevant to rebut arguments made to the PTO that the art taught away from the display of large peptides on the surface of phage. Nevertheless, the Examiner of the '108 case found that the applicants' arguments regarding that issue had already been rebutted by U.S. Patent No. 5,427,908 to Dower *et al.*, which was already of record in that case and is of record in the present application.

MorphoSys has further alleged that CAT has committed inequitable conduct for their alleged failure to point out the inventor and invention date of each claim that was not commonly owned by CAT and The Medical Research Council ("MRC"), both assignees of the '108 patent, at the time a later invention was made to allow consideration of the applicability of 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. § 103(a). MorphoSys alleges that CAT has failed to show that the subject matter and the claims were, at the time the invention was made, commonly owned. CAT's position supported by deposition testimony (attached herewith) is that there was a clear understanding that the subject matter of each and every claim was commonly owned at all times and the later written agreements submitted herewith simply memorialized the basic understanding between CAT and MRC.

The following documents are being submitted herewith which were recently filed, held or are relevant to the litigation involving the parent of this application in the U.S.

District Court District of Columbia (U.S. District Court, District of Columbia, Civil Action No. 1:00 CV 00146).

1. First Amended Complaint, filed March 8, 2002;
2. Cambridge Antibody Technology Limited's Answer to First Amended Complaint, filed March 22, 2002;
3. Redacted Agreement between Medical Research Council, Cambridge Antibody Technology Limited and Cambridge Antibody Technology Group plc, dated 1/7/97 (**Subject to the Petition to Expunge**);
4. Deposition Transcript of David W. Clough, taken April 19, 2002;
  - a. E. I. du Pont de Nemours & Co. v. Cetus Corp., 19 USPQ2d 1174, (DC D/N.Cal. 1990) cited in Deposition Transcript of David W. Clough, taken April 19, 2002;
  - b. OddzOn Products Inc. v. Just Toys Inc., 43 USPQ2d 1641 (CAFC 1997), cited in Deposition Transcript of David W. Clough, taken April 19, 2002;
5. Deposition Transcript of George P. Smith, Ph.D., taken May 14, 2002;
6. Deposition Transcript of Dr. David Chiswell, taken April 29, 2002;
7. Deposition Transcript of Dr. Gregory Paul Winter, taken April 30, 2002;
8. Volume I – Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002;
9. Volume II – Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002;
10. Chiswell memo, dated July 30, 1990, transmitting a copy of the Collaborative Agreement between Cambridge Antibody Technology and The Medical Research Council, dated July 27, 1995 (**Subject to the Petition to Expunge**);
11. Declaration of George P. Smith Under 37 C.F.R. § 1.132, executed June 30, 1995 (submitted during the prosecution of U.S. Application No. 08/322,352);

12. Declaration of Professor Brian K. Kay, Ph.D., executed June 28, 1998 (submitted during the prosecution of European Patent Application No. 91913039.3);
13. Abstract of George P. Smith Grant No. 1R01GM41478-01A1.
14. Smith Grant Application, dated November 1, 1988; and
15. Administration Agreement between Cambridge Antibody Technology Ltd. and Medical Research Council, 8/1/91 (**Subject to the Petition to Expunge**).
16. Fax from John McCafferty (of Cambridge Antibody Technology Limited) to S. Walton (of Mewburn Ellis) Re: Smith Grant Application.
17. E-mail message from John McCafferty (of Cambridge Antibody Technology Limited) to Brian Kay Re: Smith Grant Application.
18. Letter from John McCafferty (of Cambridge Antibody Technology Limited) to Craig Palmer (of Academic Press) Re: Smith Grant Application.
19. Fax to John McCafferty (of Cambridge Antibody Technology Limited) from Craig Panner (of Academic Press) dated June 10, 1996.
20. Smith, G. P., "1988 – A Year of Discovery", *Phage Display of Peptides and Proteins*, Academic Press, Inc. (1996), pp. xvii-xix.
21. Northern Telecom Inc. v. Datapoint Corp., 15 USPQ 1321 (CAFC 1990).

Documents 1-12 and 15 are individually listed below with cites to the relevant testimony.

**First Amended Complaint, filed March 8, 2002**

Page	Line	
6	1	Allegations regarding Smith grant/
thru		inequitable conduct
21	12	

**Cambridge Antibody Technology Limited's  
Answer to First Amended Complaint, filed March 22, 2002**

Page	Line	
7	8	Response to allegations regarding Smith grant/
thru		inequitable conduct
29	22	

**Deposition Transcript of David W. Clough, taken April 19, 2002**

Page	Line	
21	10	Testimony regarding Smith grant
thru		
25	10;	
27	1-15;	
29	10	
thru		
32	24;	
33	11	
thru		
40	20;	
46	4-10;	
55	22	
thru		
57	16;	
65	10	
thru		
66	14;	
68	10	
thru		
84	24;	
88	20	
thru		
95	5;	
96	16-19;	
97	22	
thru		
99	6;	
100	15-24;	
101	12-21;	
102	22	
thru		
104	24;	

**Deposition Transcript of David W. Clough, taken April 19, 2002 (Continued)**

Page Line

105 13

Testimony regarding Smith grant

thru

108 4;

108 13-22;

109 14-20

111 1

thru

112 3;

123 3-15;

125 1

thru

131 2;

131 12

thru

132 8;

141 12-15;

142 3-15;

148 9

thru

152 7;

153 10

thru

154 14;

155 14

thru

156 9;

176 8-24

105 13

Testimony regarding '96 knowledge of Smith grant

thru

109 20

171 15

thru

175 12

Page Line

176 18

Testimony regarding DuPont v. Cetus

thru

177 20

Page Line

179 14-15

Testimony regarding Oddzn Products v. Just Toys Inc.

**Deposition Transcript of George P. Smith, Ph.D., taken May 14, 2002**

Page	Line	
31	8	Testimony regarding Smith grant
thru		
39	17;	
40	4	
thru		
49	15;	
50	25	
thru		
53	25;	
61	20	
thru		
62	12;	
64	5	
thru		
65	25;	
67	6	
thru		
68	8;	
92	1-22;	
100	24	
thru		
101	13;	
104	10-17;	
106	12-21;	
111	7	
thru		
112	12;	
132	12-25;	
141	21	
thru		
142	16;	
143	14	
thru		
146	25;	
148	23	
thru		
149	1;	
155	14-22;	
157	8	
thru		
158	4;	
162	8-20;	



**Deposition Transcript of George P. Smith, Ph.D., taken May 14, 2002**

Page	Line	
166	10	Testimony regarding Smith grant
thru		
167	12;	
183	2-23.	

**Deposition Transcript of Dr. David Chiswell, taken April 29, 2002**

Page	Line	
119	23	Testimony regarding Smith grant
thru		
124	1;	
128	5	
thru		
129	5;	
204	19	
thru		
209	22	

Page	Line	
37	2	Testimony regarding Chiswell memo
thru		
66	4;	
94	17	
thru		
96	2	

Page	Line	
None		Testimony regarding '96 knowledge of Smith grant

Page	Line	
157	7	Testimony regarding common ownership
thru		
158	17;	
215	19	
thru		
219	15	

**Deposition Transcript of Dr. Gregory Paul Winter, taken April 30, 2002**

Page	Line	
123	11-14;	Testimony regarding Smith grant
130	22	
	thru	
139	14.	

Page	Line	
None		Testimony regarding '96 knowledge of Smith grant

Page	Line	
74	1	Testimony regarding common ownership
	thru	
77	22	
79	16	
	thru	
80	16	
82	1-11	
181	18	
	thru	
182	24	
222	3	Testimony regarding common ownership

	thru	
225	13	

**Volume I**

**Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002**

**Volume II**

**Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002**

Page	Line	
16	8	Testimony regarding Smith grant
	thru	
18	2;	
31	20	
	thru	
59	23;	
64	11	
	thru	
91	6;	

**Volume I**  
**Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002**  
**Volume II**  
**Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002**  
**(Continued)**

Page	Line	
93	25	Testimony regarding Smith grant:
	thru	
95	9;	
95	19	
	thru	
96	4;	
97	19	
	thru	
106	21;	
108	14	
	thru	
109	23;	
110	12	
	thru	
111	1;	
132	17-23;	
133	15	
	thru	
140	25;	
165	21	
	thru	
166	18;	
170	1-9;	
173	16	
	thru	
176	11;	
199	6	
	thru	
208	23;	
228	11-13;	
230	8-16;	
231	7-9;	
232	25	
	thru	
243	22;	
246	16	
	thru	
247	10;	

**Volume I**  
**Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002**  
**Volume II**  
**Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002**  
**(Continued)**

Page	Line	
249	23	Testimony regarding Smith grant:
thru		
257	22;	
267	5	
thru		
268	18;	
270	21	
thru		
277	22;	
285	2	
thru		
289	19;	
321	24	
thru		
322	13;	
322	18-23;	
323	5	
thru		
328	11	

Page	Line	
82	17	Testimony regarding '96 knowledge of Smith grant:
thru		
90	8;	
95	19	
thru		
96	4;	
97	19	
thru		
101	5;	
103	3	
thru		
106	21;	
108	14	
thru		
111	1;	

**Volume I**  
**Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002**  
**Volume II**  
**Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002**  
**(Continued)**

Page	Line	
133	15	Testimony regarding '96 knowledge of Smith grant:
	thru	
140	25;	
205	5	
	thru	
208	23;	
271	19	
	thru	
277	22;	
285	2	
	thru	
289	19; and	
321	24	
	thru	
328	11	
Page	Line	
179	22	Testimony regarding common ownership:
	thru	
184	17;	
186	16	
	thru	
191	8;	
192	22	
	thru	
195	19	

**Chiswell memo, dated July 30, 1990,**  
**(transmitting a copy of the Collaborative Agreement between Cambridge Antibody**  
**Technology and The Medical Research Council, dated July 27, 1995)**  
**(Subject to Petition to Expunge)**

**Declaration of George P. Smith Under 37 C.F.R. § 1.132**

Page	Line	
2	7-9;	Inequitable conduct
4	3-9	

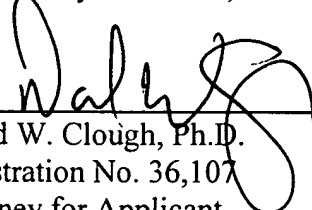
RECEIVED  
MAY 12 2003  
TECH CENTER 1600/2900

Finally, attorney for applicants submit herewith a reference (Il'ichev, A.A., *et al.*, "M13 Filamentous Bacteriophage in Protein Engineering", *Molekulyarnaya Biologiya*, Vol. 24, No. 2, pp. 530-535, (March-April 1990)(two versions – one in Russian (with a one-page abstract) and a translation of the same reference) and a patent which were recently brought to applicants' attention.

In addition, a copy of the references cited made necessary by ongoing proceedings in the European Patent Office in connection with a relative European application, which were brought to our attention less than three months prior to the filing of this Information Disclosure Statement.

The Commissioner is hereby authorized to charge any additional fees which may be required in this application under 37 C.F.R. §§1.16-1.17 during its entire pendency, or credit any overpayment, to Deposit Account No. 50-1214. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-1214.

Respectfully submitted,

  
\_\_\_\_\_  
David W. Clough, Ph.D.  
Registration No. 36,107  
Attorney for Applicant

May 5, 2003  
Katten Muchin Zavis Rosenman  
525 West Monroe Street, Suite 1600  
Chicago, Illinois 60661-3696  
(312) 902-5464  
(312) 557-8736

The PTO did not receive the following  
listed item(s) the check



PTO/SB/08A (10-01)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Sheet 1 of 10

Substitute for form 1449A/PTO <b>INFORMATION DISCLOSURE</b> <b>STATEMENT BY APPLICANT</b> (Use several sheets if necessary)										Docket Number 213839-00013			Application Number 09/726,219					
										Applicant McCafferty <i>et al.</i>								
										Filing Date November 28, 2000			Group Art Unit 1627					
<b>U. S. PATENT DOCUMENTS</b>																		
EXAMINER INITIAL		DOCUMENT NUMBER							DATE		NAME		CLASS		SUB CLASS		FILING DATE IF APPROP.	
A1		6	3	3	1	4	1	5			Cabilly et al.		435		69.6		6/10/88	
A2		07/	2	4	0	1	6	0	3/22/90		Ladner application							
<b>FOREIGN PATENT DOCUMENTS</b>																		
		DOCUMENT NUMBER							DATE		COUNTRY		CLASS		SUB CLASS		Translation Yes No	
B1		WO 88/01649							3/10/88		PCT							
B2		GB9022845.3							10/19/90		Great Britain							
B3		GB9024503.6 patent application							11/12/90		Great Britain							
B4		GB 9104744.9 patent application							3/6/91		Great Britain							
B5		EP-A-0 368 684							5/16/90		Great Britain							
B6		GB9015198.6 priority document							7/10/90		Great Britain							
B7		GB 9022845.3 priority document							10/19/90		Great Britain							
B8		GB 9104744.9 priority document							3/6/91		Great Britain							
B9		GB9110549.4 priority document							5/15/91		Great Britain							
B10		EP-B-0 349 578 B1							11/30/94		Great Britain							
<b>OTHER DOCUMENTS</b> (Including Author, Title, Date, Pertinent Pages, Etc.)																		
C1		First Amended Complaint, Filed March 8, 2002 - Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (24 pages) (U.S. District Court, District of Columbia)(signed by John S. Skilton, Attorney for Plaintiff.)																
C2		Cambridge Antibody Technology Limited's Answer to First Amended Complaint, Filed March 22, 2002 - Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia)(signed by Brian H. Corcoran, Attorney for Defendant).																
EXAMINER										DATE CONSIDERED								
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.																		



PTO/SB/08A (10-01)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Sheet 2 of 10

Substitute for form 1449A/PTO		Docket Number 213839-00013	Application Number 09/726,219
<b>INFORMATION DISCLOSURE</b>  <b>STATEMENT BY APPLICANT</b>  (Use several sheets if necessary)		Applicant McCafferty <i>et al.</i>	
		Filing Date November 28, 2000	Group Art Unit 1627
<b>OTHER DOCUMENTS</b> (Including Author, Title, Date, Pertinent Pages, Etc.)			
C3	Il'ichev, A.A., <i>et al.</i> , "M13 Filamentous Bacteriophage in Protein Engineering", Molekulyarnaya Biologiya, Vol. 24, No. 2, pp. 530-535, (March-April 1990).		
C4	Iliychev, A.A., <i>et al.</i> , "M13 Filamentous Bacteriophage for Protein Engineering", Molekulyarnaya Biologiya, Vol. 24, No. 2, pp. 530-535, (March-April 1990). (In Russian with Translated Abstract)		
C5	Redacted Agreement Between Medical Research Council and Cambridge Antibody Technology Limited and Cambridge Antibody Technology Group plc, made 01 January 1997		
C6	Deposition Transcript of David W. Clough, taken April 19, 2002 (Morphosys AG v. Cambridge Antibody Technology Limited, U.S. District Court, Northern District of Illinois, Eastern Division).		
C7	E.I. du Pont de Nemours v. Cetus Corp., 19 USPQ2d 1174, (DC N.Cal. 1990).		
C8	OddzOn Products Inc. v. Just Toys Inc., 43 USPQ2d 1641(CAFC 1997).		
C9	Deposition Transcript of George P. Smith, Ph.D., taken 14 May 2002, Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia.)		
C11	Deposition Transcript of Dr. David Chiswell, taken 29 April 2002; Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia.)		
C12	Deposition Transcript of Dr. Gregory Paul Winter, taken April 30, 2002; Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia.)		
C13	Vol. I - Deposition Transcript of Sean Malcolm Walton, taken 01 May 2002, Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia.)		
EXAMINER		DATE CONSIDERED	
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.			

RECEIVED  
MAY 12 2003  
TECH CENTER 1600/2900





PTO/SB/08A (10-01)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Sheet 3 of 10

<b>Substitute for form 1449A/PTO</b>  <b>INFORMATION DISCLOSURE</b>  <b>STATEMENT BY APPLICANT</b>  (Use several sheets if necessary)		Docket Number <b>213839-00013</b>	Application Number <b>09/726,219</b>
		Applicant <b>McCafferty et al.</b>	
		Filing Date <b>November 28, 2000</b>	Group Art Unit <b>1627</b>
<b>OTHER DOCUMENTS</b> (Including Author, Title, Date, Pertinent Pages, Etc.)			
C14	Vol. II - Deposition Transcript of Sean Malcolm Walton, taken 02 May 2002, Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia.)		
C15	Chiswell memo, dated 30 July 1990, transmitting a copy of the Collaborative Agreement between Cambridge Antibody Technology and The Medical Research Council, dated July 27, 1995.		
C16	Declaration of George P. Smith, Ph.D., Under 37 C.F.R. § 1.132, executed 30 June 1995 (submitted during the prosecution of U.S. Application No. 08/322,352).		
C17	Declaration of Brian K. Kay, Ph.D., executed 28 June 1998, (submitted during the prosecution of European Appln. No. 91913039.3)		
C18	Abstract of George P. Smith, Grant No. 1R01GM41478-01A1, Project Start Date: July 1, 1989, Dept. of Health & Human Services.		
C19	Smith Grant Application, entitled: "Filamentous Phage Physiology", dated November 1, 1988		
C20	Administration Agreement between Cambridge Antibody Technology Ltd. and Medical Research Council, dated 01 August 1991 (Redacted).		
C21	Fax from John McCafferty (of Cambridge Antibody Technology Limited) to Sean Walton (of Mewburn Ellis) regarding the Smith grant application.		
C22	E-mail message from John McCafferty (of Cambridge Antibody Technology Limited) to Brian Kay regarding the Smith grant application		
C23	Letter to Craig Panner (of the Academic Press) from John McCafferty (Cambridge Antibody Technology Limited) regarding the Smith grant application		
C23 A	Fax to John McCafferty, Ph.D. (of Cambridge Antibody Technology Limited) from Craig Panner (of Academic Press) dated June 10, 1996.		
C24	Smith, G. P., "1988 - A Year of Discovery", <i>Phage Display of Peptides and Proteins</i> , Academic Press, Inc. (1996), pp. xvii-xix.		
C25	Northern Telecom Inc. v. Datapoint Corp., 15 USPQ 1321., (CAFC 1990).		
C26	Letter of Dr. Smith Re: NIH grant proposals, Dated June 27, 1997		
EXAMINER		DATE CONSIDERED	
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.			

RECEIVED  
MAY 12 2003  
TECH CENTER 1600/2900



PTO/SB/08A (10-01)

Approved for use through 10/31/2002. OMB 0651-0031

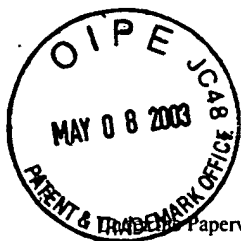
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Sheet 4 of 10

<b>Substitute for form 1449A/PTO</b>  <b>INFORMATION DISCLOSURE</b>  <b>STATEMENT BY APPLICANT</b>  (Use several sheets if necessary)		<b>Docket Number</b> 213839-00013	<b>Application Number</b> 09/726,219
		<b>Applicant</b> McCafferty <i>et al.</i>	
		<b>Filing Date</b> November 28, 2000	<b>Group Art Unit</b> 1627
<b>OTHER DOCUMENTS</b> (Including Author, Title, Date, Pertinent Pages, Etc.)			
C27	Barbas and Lerner "Combinatorial Immunoglobulin Libraries on the surface of phage (Phabs): rapid selection of anti-specific fabs." Methods: a companion to methods in Enzymology Vol. 2 (2): 119-124 (1991).		
C28	Interlocutory Decision in Opposition Proceedings to the European Patent EP-B-0589877 dated April 15, 2002 (reference number SMW/CP9503921)		
C29	Notice of Appeal to the European Patent EP-B-0589877 from Dyax Corp., filed June 17, 2002		
C30	Communication from EPO on Notice of Appeal filed by Dyax, issued October 21, 2002		
C31	Notice of Appeal to the European Patent EP-B-0589877 from BioInvent Therapeutic AB, filed June 14, 2002		
C32	Appeal No. T0639/02-334 from BioInvent Therapeutic AB to the European Patent EP-B-0589877, filed August 22, 2002		
C33	Notice of Appeal to the European Patent EP-B-0589877 from MorphoSys AG filed June 20 2002 and Grounds of the Appeal filed August 22, 2002		
C34	Notice of Appeal filed June 24, 2002 and Grounds of Appeal filed August 22, 2002 from Cambridge Antibody Technology Limited against the Decision of the Opposition Division		
C35	Notice of Opposition to the European Patent EP-B-0589877 from BioInvent International AB, filed October 24 2002		
C36	Document D80 in Appeal No. T0639/02-334: HHS' Freedom of Information Act (FOIA) regulations: table of contents, 5.1, 5.2, 5.3, 5.5, 5.21, 5.22, 5.24, 5.31, 5.32, 5.33, 5.34, 5.35, 5.51, 5.61 and 5.65		
C37	Document D81 in Appeal No. T0639/02-334: Smith Declaration		
C38	Document D82 in Appeal No. T0639/02-334: Copy of Grant Application GM 41478 and renewal applications supplied by the DHH		
<b>EXAMINER</b>		<b>DATE CONSIDERED</b>	
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.			

RECEIVED  
MAY 13 2003  
TECH CENTER 1600/2900



PTO/SB/08A (10-01)

Approved for use through 10/31/2002. OMB 0651-0031

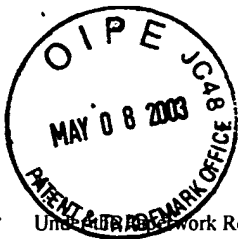
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Sheet 5 of 10

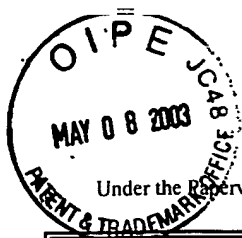
<b>Substitute for form 1449A/PTO</b>  <b>INFORMATION DISCLOSURE</b>  <b>STATEMENT BY APPLICANT</b>  (Use several sheets if necessary)		<b>Docket Number</b> 213839-00013	<b>Application Number</b> 09/726,219
		<b>Applicant</b> McCafferty <i>et al.</i>	
		<b>Filing Date</b> November 28, 2000	<b>Group Art Unit</b> 1627
<b>OTHER DOCUMENTS</b> (Including Author, Title, Date, Pertinent Pages, Etc.)			
C39	Document D83 in Appeal No. T0639/02-334: Letter dated 26 August 1999 from Cambridge Antibody Technology Ltd in opposition proceedings against EP 0 527 839		
C40	Document D85 in Appeal No. T0639/02-334: Proprietor's letter of 12 November 1997 and amended claims		
C41	Document D86 in Appeal No. T0639/02-334: EP 0774 511 A1		
C42	Document D87 in Appeal No. T0639/02-334: Proprietor's letter of 15 November 2000		
C43	Document D88 in Appeal No. T0639/02-334: Grounds of Appeal dated 22 August 2002 from present opponent in opposition proceedings against EP 0589 877		
C44	Document D89 in Appeal No. T0639/02-334: OD's Written Interlocutory Decision in opposition proceedings against EP 0 589 877		
C45	Document D90 in Appeal No. T0639/02-334: Marvin & Hohn (1969). Bacteriological Rev 33(2), 172-209		
C46	Document D91 in Appeal No. T0639/02-334: Better et al. (1988). Science 240, 1041-1043		
C47	Document D92 in Appeal No. T0639/02-334: Sambrook & Russel (2001). Molecular cloning: a laboratory manual 3rd Edition, Cold Spring Harbor Press; particular pages 18.115 to 18.122 "Filamentous phage display"		
C48	Notice of Opposition to the European Patent EP-B-0589877 from Crucell Holland B.V, filed October 30 2002		
C49	Document D13: Communication of the European Office of 28 June 2001		
C50	Document D17: Vieira and Messing (1987), Methods Enzymol. 153, 3-11		
<b>EXAMINER</b>		<b>DATE CONSIDERED</b>	
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.			

RECEIVED  
MAY 12 2003  
TECH CENTER 1600/2300



Substitute for form 1449A/PTO <b>INFORMATION DISCLOSURE</b> <b>STATEMENT BY APPLICANT</b> (Use several sheets if necessary)		Docket Number 213839-00013	Application Number 09/726,219
		Applicant McCafferty <i>et al.</i>	
		Filing Date November 28, 2000	Group Art Unit 1627
<b>OTHER DOCUMENTS</b> (Including Author, Title, Date, Pertinent Pages, Etc.)			
C51	Document D27: Details of Smith Grant application and second and third year renewals thereof as provided by the DHHS in response to a Freedom to Information Act (FOIA) request		
C52	Notice of Opposition to the European Patent EP-B-0589877 from Dyax Corp.		
C53	Document D1: EPO register print-out for the patent application with file history information		
C54	Document D3: Claims filed with the divisional application		
C55	Document D7: Pluckthun and Skerra, "Expression of functional antibody Fv and Fab fragments in <i>Escherichia coli</i> ," <i>Methods in Enzymology</i> , Vol. 178 (1989), pages 497-515		
C56	Document D8: Hoogenboom et al., "Multi-subunit proteins on the surface of filamentous phage: methodology for displaying antibody (Fab) heavy and light chains," <i>Nucleic Acids Research</i> , Vol 19, No. 15 (1991), pages 4133-4137.		
C57	Notice of Opposition to the European Patent EP-B-0589877 from MorphoSys, filed October 30 2002		
C58	Document D1: Genentech, US Patent Application 07/621,667, priority document to EP 92902109.5		
C59	Opposition to European patent EP-B-0589877, cited opposition document D2: Nelson et al. "Filamentous phage DNA cloning vectors: a noninfective mutant with a nonpolar deletion in gene III", <i>Virology</i> 108: 338-350 (1981)		
C60	Opposition to European patent EP-B-0589877, cited opposition document D3: McCoy and Khorana "Introduction and characterization of amber mutations in the bacteriorhodopsin gene", <i>J. Bio. Chem.</i> 258: 8456-8461 (1983)		
C61	Opposition to European patent EP-B-0589877, cited opposition document D5: Bullock et al. "XL1-blue: a high efficiency plasmid transforming <i>recA</i> <i>Escherichia coli</i> strain with beta-galactosidase selection", <i>Bio Techniques</i> 5: 376-378 (1987)		
C62	Opposition to European patent EP-B-0589877, cited opposition document D6: Schnee et al. "Construction and expression of a recombinant antibody-targeted plasminogen activator", <i>Proc. Natl. Acad. Sci. USA</i> 84:6904-6908 (1987)		
EXAMINER		DATE CONSIDERED	
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.			

RECEIVED  
MAY 12 2003  
TECH CENTER 1600/2906



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Sheet 7 of 10

Substitute for form 1449A/PTO

**INFORMATION DISCLOSURE****STATEMENT BY APPLICANT**

(Use several sheets if necessary)

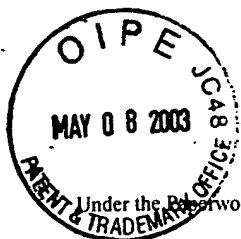
Docket Number  
213839-00013Application Number  
09/726,219Applicant  
McCafferty *et al.*Filing Date  
November 28, 2000Group Art Unit  
1627**OTHER DOCUMENTS** (Including Author, Title, Date, Pertinent Pages, Etc.)

C63	Opposition to European patent EP-B-0589877, cited opposition document D9: De La Cruz et al. "Immunogenicity and epitope mapping of foreign sequences via genetically engineered filamentous phage", <i>J. Bio. Chem.</i> 263: 4318-4322 (1988)
C64	Opposition to European patent EP-B-0589877, cited opposition document D15: Parmley and Smith "Filamentous fusion phage cloning vectors for the study of epitopes and design of vaccines", <i>Adv. Exp. Med. Biol.</i> 251: 215-218 (1989)
C65	Opposition to European patent EP-B-0589877, cited opposition document D18: Chaudhary et al. "A recombinant immunotoxin consisting of two antibody variable domains fused to <i>Pseudomonas</i> exotoxin", <i>Nature</i> 339: 394-397 (1989)
C66	Opposition to European patent EP-B-0589877, cited opposition document D23: US 517 659 "Affymax priority document", entitled "Recombinant Library Screening Methods", priority document filed 1 May 1990 for EP-A-0 527 839 (Article 54(3) EPC)
C67	Opposition to European patent EP-B-0589877, cited opposition document D26: Scott and Smith "Searching for peptide ligands with an epitope library", <i>Science</i> 249: 386-389 (1990)
C68	Opposition to European patent EP-B-0589877, cited opposition document D27: Devlin et al. "Random peptide libraries: a source of specific protein binding molecules", <i>Science</i> 249: 404-405 (1990)
C69	Opposition to European patent EP-B-0589877, cited opposition document D37: Markland et al. "Design, construction and function of a multicopy display vector using fusions to the major coat protein of bacteriophage M13", <i>Gene</i> 109: 13-19 (1991)
C70	Opposition to European patent EP-B-0589877, cited opposition document D38: Roberts et al. "Directed evolution of a protein: selection of potent neutrophil elastase inhibitors displayed on M13 fusion phage", <i>Proc. Natl. Acad. Sci. USA</i> 89: 2429-2433 (1992)
C71	Opposition to European patent EP-B-0589877, cited opposition document D39: Glockshuber et al. "The disulfide bonds in antibody variable domains: effects on stability, folding in vitro, and functional expression in <i>Escherichia coli</i> ", <i>Biochemistry</i> 31: 1270-1279 (1992)
C72	Opposition to European patent EP-B-0589877, cited opposition document D41: Kay et al. "Phage display of peptides and proteins", <i>A laboratory Manual</i> (1996) (Cover page and Foreword enclosed)
C73	Opposition to European patent EP-B-0589877, cited opposition document D42: Proba et al. "A natural antibody missing a cysteine in V <sub>H</sub> : consequences for thermodynamic stability and folding", <i>J. Mol. Biol.</i> 265: 161-172 (1997)

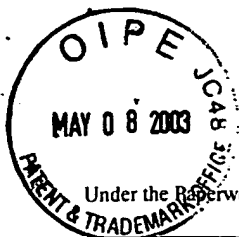
EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.



Substitute for form 1449A/PTO <b>INFORMATION DISCLOSURE</b> <b>STATEMENT BY APPLICANT</b>  (Use several sheets if necessary)		Docket Number 213839-00013	Application Number 09/28/2000
		Applicant McCafferty <i>et al.</i>	
		Filing Date November 28, 2000	Group Art Unit 16277
<b>OTHER DOCUMENTS</b> (Including Author, Title, Date, Pertinent Pages, etc.)			
C74	Opposition to European patent EP-B-0589877, cited opposition document D43: Proba et al. "Antibody scFv fragments without disulfide bonds made by molecular evolution", <i>J. Mol. Biol.</i> 275: 245-253 (1998)		
C75	Opposition to European patent EP-B-0589877, cited opposition document D44: Letter of 18 November 1992 to EPO from Kilburn Strode in prosecution of EP-B-0 349 578		
C76	Opposition to European patent EP-B-0589877, cited opposition document D45: Page 3 of EPO letter of 19 October 1993 addressed to Plougmann, Ole (c/o Plougmann Vingtoft A/S) in prosecution of EP-B-0 768 377		
C77	Opposition to European patent EP-B-0589877, cited opposition document D46: Letter of 22 September 1994 to EPO from Plougmann & Vingtoft in prosecution of EP-B-0 768 377		
C78	Opposition to European patent EP-B-0589877, cited opposition document D47: Extract from OD Decision in opposition proceedings against EP-B-0 201 184, (1995)		
C79	Opposition to European patent EP-B-0589877, cited opposition document D48: Letter of 14 February 1996 to EPO from Hepworth, Lawrence, Bryer & Bizley in prosecution of EP-A-0 527 839, 1996		
C80	Opposition to European patent EP-B-0589877; cited opposition document D49: the Boards of Appeal of the European Patent Office decision of 8 May 1996, case number T694/92 - 3.3.4		
C81	Opposition to European patent EP-B-0589877, cited opposition document D50: Extract from opposition proceeding against EP-B-0 349 578 (1996)		
C82	Opposition to European patent EP-B-0589877, cited opposition document D51: Extract from OD Decision in proceedings against EP-B-0 349 578 (1998)		
C83	Opposition to European patent EP-B-0589877, cited opposition document D53: Declaration of professor sir Aaron Klug, Ph.D. with exhibits, (23 June 1998)		
C84	Opposition to European patent EP-B-0589877, cited opposition document D54: preprint of paper by Scott and Smith submitted to Science		
C85	Opposition to European patent EP-B-0589877, cited opposition document D55: Smith grant application		
EXAMINER		DATE CONSIDERED	
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.			



<b>Substitute for form 1449A/PTO</b>  <b>INFORMATION DISCLOSURE</b>  <b>STATEMENT BY APPLICANT</b>  (Use several sheets if necessary)		Docket Number 213839-00013	Application Number 09/726,219
		Applicant McCafferty <i>et al.</i>	
		Filing Date November 28, 2000	Group Art Unit 1627
<b>OTHER DOCUMENTS</b> (Including Author, Title, Date, Pertinent Pages, Etc.)			
C86	Opposition to European patent EP-B-0589877, late filed document D56: claim for infringement of 24 September 1998, from Cambridge Antibody Technology Limited to EPO		
C87	Opposition to European patent EP-B-0589877, late filed document D58: McConnell <i>et al.</i> "Constrained peptide libraries as a tool for finding mimotopes", <i>Gene</i> 151: 115-118 (1994).		
C88	Opposition to European patent EP-B-0589877, late filed document D59: two chapters of "Lambda II" (eds. Hendrix <i>et al.</i> ) Cold Spring Harbour Laboratory, Cold Spring Harbour, New York, 1983: "A Beginner's Guide to Lambda Biology" (Arber) (pp. 381-395) and "Tail Assembly and Injection" (Katsura)(pp. 331-346).		
C89	Opposition to European patent EP-B-0589877, late filed document D60: Parmley & Smith "Filamentous fusion phage cloning vectors for the study of epitopes and design vaccines", <i>Adv. Exp. Med. Biol.</i> 251: 251-8 (1989).		
C90	Opposition to European patent EP-B-0589877, late filed document D63: Declaration of William D. Huse, MD, Ph.D. (17 August 1999		
C91	Opposition to European patent EP-B-0589877, late filed document D66: Crissman & Smith, "Gene-III protein of filamentous phages: evidence for a carboxyl-terminal domain with a role in morphogenesis", <i>Virology</i> 132: 445-455 (1994).		
C92	Opposition to European patent EP-B-0589877, late filed document D67: Declaration of Dr. Viia Valge-Archer (3 May, 2000)		
C93	Opposition to European patent EP-B-0589877, late filed document D68: Declaration of Dr. Hiroshi Ueda (3 May, 2000)		
C94	Opposition to European patent EP-B-0589877, late filed document D69: First Declaration of Dr. Rachel B. Kent (4 February, 2000).		
C95	Opposition to European patent EP-B-0589877, late filed document D71: letter of patentees filed at USPTO on 16 July 1996.		
C96	Opposition to European patent EP-B-0589877, late filed document D72: letter of patentees filed at USPTO on 6 March 1997.		
C97	Opposition to European patent EP-B-0589877, late filed document D73: Opposition by CAT against EP-B-0 564 531.		
EXAMINER		DATE CONSIDERED	
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.			

RECEIVED  
MAY 12 2003  
TECH CENTER  
1600/290



Approved for use through 10/31/2002. OMB 0651-0031  
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Sheet 10 of 10

Substitute for form 1449A/PTO <b>INFORMATION DISCLOSURE</b> <b>STATEMENT BY APPLICANT</b> (Use several sheets if necessary)	Docket Number 213839-00013	Application Number 09/726,219
	Applicant McCafferty <i>et al.</i>	
	Filing Date November 28, 2000	Group Art Unit 1627

**OTHER DOCUMENTS** (Including Author, Title, Date, Pertinent Pages, Etc.)

C98	Opposition to European patent EP-B-0589877, late filed document D74: Decision of EPOD on EP-B-0 201 184.
C99	Opposition to European patent EP-B-0589877, late filed document D75: Declaration of Prof. Andreas Plückhun (3 May, 2000).
C100	Opposition to European patent EP-B-0589877, late filed document D76: Notice of grant awarded to Smith grant application.
C101	Opposition to European patent EP-B-0589877, late filed document D77: Endemann and Model "Location of filamentous phage minor coat proteins in phage and in infected cells", <i>J. Mol. Biol.</i> 250: 496-506 (1995). The document was objected to by patentees.
C102	Opposition to European patent EP-B-0589877, late filed document D79: Extract from MorphoSys website.
C103	Opposition to European patent EP-B-0589877, late filed document D80: Written Decision dated 26 May 2000 to revoke EP-B-0436597.
C104	Opposition to European patent EP-B-0589877, late filed document D81: 2nd Declaration of Dr. Viia Valge-Archer (31 May, 2000).
C105	
C106	
C107	
C108	
C109	

RECEIVED  
MAY 12 2003  
TECH CENTER 1600/2900

EXAMINER	DATE CONSIDERED
----------	-----------------

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.